

REMARKS

Claims 1-3, 5 and 13 were rejected as being anticipated by Nunzi. This rejection is respectfully traversed and should be withdrawn because claim 1 now includes the limitation of claim 6.

Claims 4, 6-12 and 14-16 were rejected as being obvious over Nunzi. This rejection is respectfully traversed.

Claim 6 recites that the elastimer has a thickness change of at least about 1 percent by the application of 1 volt across a 1 mm thick film of the elastimer. The Examiner has argued that claim 6 would have been obvious because “the combination discloses such features as [a] result of the proper choice of materials.” Please see page 4, starting at line 5 from the bottom. This argument is totally *without* any merit because the Examiner has provided *no evidence* from Nunzi or any other prior art of record to support this statement.

In particular, what “combination discloses such features?” Foremost, Nunzi has not been combined with any secondary reference in making the obviousness rejection. So, where does the “combination” arise from? It appears that the Examiner’s “combination” arises from Nunzi and something that he has hypothesized as being “within the ordinary skill of worker in the art.” See paragraph bridging pages 3 and 4 of the Action.

Applicants wish to state their understanding that the prior art rejection of record rests on a simple premise, which is that “it is not clear if Nunzi discloses the claimed materials. However, the selection of a known material based on its suitability for its intended use does not serve as basis for patentability.” See Action, page 3. If this premise is incorrect, the rejection cannot stand.

The Examiner’s premise fails in the first instance because there is no suggestion in the prior art to select the claimed materials, in particular, at least one elastimer that has a change in thickness of at least about 1 percent by the application of 1 volt across a 1 mm thick film of the elastimer as a component of a filter of a tunable optical device. The Examiner has instead proceeded from a different premise, making generalized statements instead of providing evidence in the prior art, as set forth in the following statements made in the paragraph bridging pages 3 and 4 of the Action:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize any of the claimed materials, since it has been held to be within the ordinary skill of the worker in the art to select a known material on the basis of its suitability for the intended use.

This statement rings hollow without any *evidence* to support that a person of ordinary skill in the art would have selected at least one elastimer that has a change in thickness of at least about 1 percent by the application of 1 volt across a 1 mm thick film of the elastimer as a component of a filter of a tunable optical device. Even if the above quoted statement of the Examiner is correct, applicants respectfully submit that there is *no* evidence that a person of ordinary skill in the art would have known that an elastimer of the claimed properties would be a material suitable for a filter of a tunable optical device, unlike as alleged by the Examiner. Without such evidence, the basic premise underlying the rejection fails and takes the rejection with it.

The Examiner states, “One would have been motivated to use any of the claimed materials, *because of its availability*” (see page 4, lines 2-4, of the Action; emphasis added). The Examiner’s stated motivation begs the question of why persons of ordinary skill in this art would have been motivated to use the claimed materials in the optical device of Nunzi, particularly when the Examiner has acknowledged that “it is not clear if Nunzi discloses the claimed materials.” If Nunzi does not disclose the claimed materials, and the Examiner has not shown that any other reference discloses the claimed materials, then where is the motivation to use the claimed materials? Nowhere! Thus, faced without any evidentiary basis to argue motivation to use the claimed materials, the Examiner makes the generalized statement to argue that “one having ordinary skill” would have utilized any of the claimed materials “since it has been held to be within the ordinary skill of the worker in the art to select a known material on the basis of its suitability for the intended use.”

The Examiner’s stated motivation is such a general motivation that it does not respond to the evidentiary burden which the Examiner must satisfy to make out a *prima facie* case of obviousness. Such a motivation is so broad that it does not answer the central question of why would a person of ordinary skill in the art choose the claimed materials when there is *no* prior art of record disclosing the claimed materials. The answer is apparent: Without applicants’

disclosure and claims as a roadmap, *no* person of ordinary skill in this art would have chosen the claimed materials in a filter of a tunable optical filter. This is classic, impermissible hindsight.

The Examiner's selected motivation is, in fact, so general in the context of the relevant art that it constitutes no more than the reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d, 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). ***The Examiner's motivation applies to virtually every invention, regardless of what it might be.*** As emphasized by the court in *In re Lee*, 61 USPQ2d at 1433, the Examiner must present specific evidence of motivation, not the generalized evidence relied on in the Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have "found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs." Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that

“allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ‘237 patent, col. 4, ll. 34-38.

The reliance in the Action on the fact that “[o]ne would have been motivated to use any of the claimed materials, because of its availability” (see page 4, lines 2-4, of the Action) comes nowhere close to the analysis required by *Lee* and approved in *Thrift*.¹

Based on *Lee* and *Thrift*, the appropriate question to ask again at this point in the analysis is: why, based on Nunzi, would a person of ordinary skill in the art have had any reason to select the claimed materials, particularly an elastimer that has a change in thickness of at least about 1 percent by the application of 1 volt across a 1 mm thick film of the elastimer, *not* just any elastimer, to arrive at the claimed invention?² There is only one reasonable answer: impermissible hindsight reliance on applicants’ disclosure and claims as a roadmap to choose Nunzi and argue that a person of ordinary skill would have selected the claimed materials “on the basis of its suitability for the intended use.”³ This failure to present evidence of motivation requires that the rejection be withdrawn.

¹ By the Examiner’s logic, an article which is a combination of previously available components is *per se* not patentable. This logic is clearly contrary to the patent law in the U.S.

² Motivation or suggestion must not merely be to combine references generally; rather, it must be to specifically combine the prior art teachings in the way claimed. *ATD Corp. v. Lydall Inc.*, USPQ2d 1321 (Fed. Cir. 1998) (“Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion . . . to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.”)

³ Applicants recognize that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much “hindsight” is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art references themselves as to why persons of ordinary skill in the art would have been motivated to combine the

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disclosures so as to arrive at the claimed invention. Applicants' position rests on the Examiner's failure to produce and rely on objective evidence of motivation in the prior art itself.